



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*oh*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/618,424	07/18/00	TAYA	49979

HM12/0508

EDWARDS & ANGELL LLP  
DIKE BROWNSTEIN ROBERTS & CUSHMAN  
130 WATER STREET  
BOSTON MA 02109

EXAMINER

MCCAA, T

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/618,424

Applicant(s)

TAYA ET AL.

Examiner

Terri L Ivory - McCaa

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1,5-10 and 15, drawn to a method and kit for detecting acetyltransferase activity in a peptide, classified in class 435, subclass 7.1.
  - II. Claims 2,5-10 and 15, drawn to a method and kit for screening a compound that inhibits or enhances the activity of acetyltransferase, classified in class 436 ; subclass 501 .
  - III. Claims 3,5-10 and 15 drawn to a method and kit for detecting the deacetylase activity in a peptide, classified in class 436 subclass 513 .
  - IV. Claims 4-10 and 15 a method and kit of screening a compound that inhibits or enhances deacetylase activity peptide, classified in class 436, subclass 528.
  - V. Claim 11, drawn to a method for screening a compound that inhibits the deacetylase activity or a compound that enhances the activity or expression of acetyltransferase , classified in class 436, subclass 519.
  - VI. Claim 12 a method for screening a compound that inhibits the deacetylase activity of histone, classified in class 436, subclass 63.
  - VII. Claims 13&14, drawn to a natural isolable compound , classified in class 252, subclass 700.

Art Unit: 1641

2. Inventions I - VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are methods for detection. Group I is a method for detecting acetyltransferase activity comprising a peptide substrate, group II is a method for screening a compound that inhibits or enhances the activity of acetyltransferase comprising test compound and a peptide substrate, group III is a method for detecting deacetylase activity in a test peptide comprising an acetylated peptide substrate. Group IV is a method for screening a compound that inhibits or enhances the deacetylase activity comprising contacting an acetylated peptide substrate and a test compound, group V is a screening method comprising immobilized cultured cells, and group VI is a screening method comprising cultured cells carrying a vector comprising a promotor that functions within the cell, and group VII is a natural isolable compound. The different inventions have a different mode of operation, different function and different effect from each other and therefore are patentably distinct.

3. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for another Group, and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. A telephone call was made to Mr. Peter Corless on February 13 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terri L Ivory - McCaa whose telephone number is 703-605-1207. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Art Unit: 1641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Terri McCaa  
Patent Examiner  
Art Unit 1641  
May 4, 2001

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP ~~1800~~/641